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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,163	01/16/2001	Florian Pestoni	ARC920000106US1	9807

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LACASSE & ASSOCIATES, LLC
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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,163	Applicant(s) PESTONI ET AL.	
	Examiner Robert W. Morgan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/16/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. The Examiner respectfully submits that an inadvertent typographical error was made in the previous Office Action (dated 3/30/05) regarding Invention I drawn to Claims 1-6, however, as noticed by Applicant, Invention I should have read "Invention I drawn to Claims 1-8".

Election/Restrictions

2. Applicant's election with traverse of Invention I, claims 1-8 in the reply filed on 4/27/05 are acknowledged. The traversal is on the ground(s) that the examiner has not provided classification that is outside of the scope of Invention I and has not provided evidence that each claimed group would require a different search from the other group. This is not found persuasive because Invention II discloses a method and a computer user medium having computer readable code for providing content insurance for distribution related to receiving a request to purchase digital insurance without submitting a claim for lost digital content and Invention III discloses a method and system of providing content insurance to a consumer via a merchant and a clearing house including third party issuing of a voucher that is transmitted to the consumer. As such, Invention II and III would require a different search for examination from that of Invention I, therefore creating a serious and undue burden for the Office.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. The information disclosure filed 1/16/01 has been acknowledge and entered in the application.

Claim Objections

4. Claim 3 is objected to because of the following informalities: line 2, reads "...wherein said said content..." duplicated "said" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over "eMedia-IT and Lloyds of London Provide Global Insurance for Digital Content" by PR Newswire (hereinafter "Newswire") in view of U. S. Patent No. 6,708,157 to Stefik et al.

As per claim 1, Newswire teaches obtaining global insurance for digital content thanks to an alliance between eMedia-IT Solutions and Lloyds of London called Insure-IT (see: abstract). Newswire also teaches that subscriber to MediaDepot offer their client the option to purchase an insurance policy specific to their community (see: paragraph 2). In addition, Newswire teaches that no application form and no approval process are necessary to obtain the insurance package for a nominal fee (see: paragraph 6). Additionally, Newswire teaches coverage includes, but is not limited to, loss of service, defamation of subscriber's reputation or character, infringement of any right to privacy, plagiarism, piracy, infringement of copyright, and damage to files (reads on "insurance insuring said consumer against loss of said specified digital content") (see: paragraph 6). Basic coverage through the MediaDepot insurance policy is \$250 (U.S.) per year (reads on "purchased content insurance") and also can be customized for subscriber's special needs (see:

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paragraph 6). Furthermore, Newswire teaches that the service provides a secure environment where creative professionals and their clients can store, revise, track (reads on “maintaining information identifying said consumer and indicating said consumer has purchased content insurance on said specified digital content”) and distribute their files throughout the world (see: paragraph 7).

Newswire fails to teach:

--the claimed receiving an indication said consumer has made a claim to recover lost digital content;

--the claimed verifying said lost digital content is the same as said specified digital content for which said content insurance was purchased; and

--the claimed enabling said consumer to receive a new copy of said specified digital content via said communication networks.

Stefik et al. teaches for controlling the distribution and use of digital work using digital tickets including a restore transaction where a request is made to convert a backup copy of a digital work into a usable copy (see: column 38, lines 6-12). In addition, Stefik et al. teaches a requester sends a message to initiate a restore transaction and a server verifies that the content file is available (i.e. a digital work corresponding to the request has been backed-up) (see: column 38, lines 13-21). Stefik et al. also teaches that the server transmits the requested contents and data to the requester according to the transmission protocol (see: column 38, lines 27-28).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include restore transaction as taught by Stefik et al. within the global insurance for digital content called Insure-IT as taught by Newswire with the motivation of providing a

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reliable and secure way of protecting and compensating a user in case of catastrophic media failure (see: Stefik et al.: column 38, lines 6-12).

As per claim 2, Stefik et al. teaches the claimed new copy of said specified digital content is in the same format as said lost digital content. This limitation is met by the restore transaction where a request is made to convert a backup copy of a digital work into a usable copy (see: column 38, lines 6-12).

As per claim 3, Stefik et al. teaches the claimed content insurance further allows said consumer to upgrade said specified content to a new encoding format. This feature met by the consumer buying the digital work with an agreement that he could upgrade to new version at a later date (see: column 46, lines 51-56).

As per claim 4, Stefik et al. teaches a consumer buys a digital work together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21). In addition, Stefik et al. teaches that when the new version becomes available, the customer can go to anyone who has the upgraded version and make the transaction (see: column 41, lines 16-21). Furthermore, Stefik et al. teaches a restore transaction where a request is made to convert a backup copy of a digital work into a usable copy (see: column 38, lines 6-12). Stefik et al. teaches that a requester sends a message (reads on "receiving an indication said consumer has made a claim") to initiate a restore transaction and a server verifies (reads on "verifying digital content") that the content file is available (i.e. a digital work corresponding to the request has been backed-up) (see: column 38, lines 13-21). Stefik et al. also teaches that the server transmits the requested contents and data to the requester (reads on "enabling said consumer to receive a new copy of said specified digital content encoded in a new

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encoding format via said communication networks”) according to the transmission protocol (see: column 38, lines 27-28).

As per claim 5, Stefik et al. teaches method further comprising:

--the claimed charging said consumer an amount for said new copy of said specified digital content encoded in a new encoding format which is a fraction of the price for a new purchase of said specified digital content in said new encoding format. This limitation is met by a consumer buying a digital work together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21).

As per claim 6, Stefik et al. teaches the claimed terms and conditions of said content insurance include any of:

a limited number of format upgrades or a limited time for which upgrades are available with the option of renewal. This limitation is met by limiting the number of format upgrades to one per copy of the digital work (see: column 47, lines 23-25).

As per claim 7, Stefik et al. teaches the claimed content insurance was purchased at a cost, which is a fraction of the price of said specified digital content. This limitation is met by a consumer buying a digital work together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21).

As per claim 8, Stefik et al. teaches the claimed terms and conditions of said content insurance includes any of:

restrictions on the number of claims that can be filed, payment of a deductible for a claim, requiring disclosure of private information by said consumer when making a claim, or having a limited term with the option of renewal. This feature is met by restrictions on the

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number of claims that can be filed to one per copy of the digital work (see: column 47, lines 23-25).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In related art (6,873,958) Artinger discloses a web-based method for identifying items to replace insured items.

In related art (6,018,714) Risen, Jr. discloses a method of providing protection against an unexpected change in value of an intellectual property asset.

In related art (NRMS Introduces the Revolutionary InsureTRUST Insurance Policy for Trusted Networks, E-Commerce and Internet Liability) Business Wire teaches a unique insurance policy directly addressing liability coverage for the unauthorized access of computer systems, along with providing complete coverage for copyright/trademark infringement and libel/slander for digital content.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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